

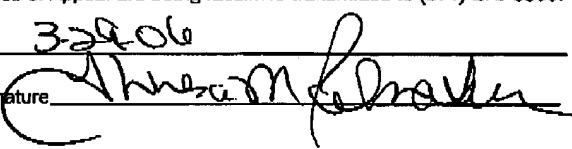
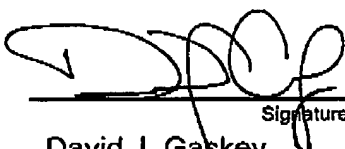
MAR 29 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0851-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | | |
|--|--|---|--------------------------------------|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 67,010-005; H2602-FN | |
| <p align="center">CERTIFICATE OF FACSIMILE</p> <p>I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300.</p> <p>on <u>3-29-06</u></p> <p>Signature <u></u></p> <p>Typed or printed name <u>Theresa M. Palmateer</u></p> | | Application Number 09/924,372 | Filed 08/08/2001 |
| | | First Named Inventor Rogan, et al. | |
| | | Art Unit 3621 | Examiner Bayat, Bradley B. |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> | | | |
| <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 37,139 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> | | <p align="center"><u></u> Signature</p> <p align="center">David J. Gaskey Typed or printed name</p> <p align="center">(248) 988-8360 Telephone number</p> <p align="center">29 MARCH 2006 Date</p> | |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | |
| <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p> | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

MAR 29 2006

67,010-005; H2602-FN

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Rogan, et al.
 Serial No.: 09/924,372
 Filed: 08/08/2001
 Group Art Unit: 3621
 Examiner: Bayat, Bradley B.
 For: METHOD AND SYSTEM FOR ELECTRONICALLY
 PROCESSING TRANSACTIONS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Dear Sir:

There is no *prima facie* case of obviousness under 35 U.S.C. §103 and none of Applicant's claims can be considered obvious. There is no motivation for making the proposed combination of *Savino, et al.* and *Sandhu, et al.* Where a proposed combination goes contrary to the teachings of the primary reference, there is no motivation for making it and the combination cannot be made. In this instance, *Savino, et al.* explicitly teach that information associated with the bar code of that reference is only entered by the customer in order to ensure reliability of such information. (See, e.g., column 4, lines 17-35 and 45-47). If one were to modify *Savino, et al.* by incorporating teachings from *Sandhu, et al.* in an attempt to somehow make an arrangement consistent with Applicant's invention (e.g., to make an arrangement where someone other than the customer enters the information), that would require violating the intentions of the

67,010-005; H2602-FN

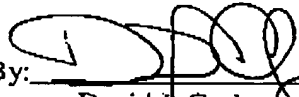
Savino, et al. reference. Such a modification cannot be made because it is directly contrary to the statement in *Savino, et al.* There is no *prima facie* case of obviousness.

The proposed addition of the teachings of *Johnston* does not remedy the defect in the basic combination. None of Applicant's claims can be considered obvious.

Additionally, Applicant notes that the Examiner refers to Applicant's own specification when attempting to explain how there is somehow some motivation for combining the references. Applicant's own specification cannot be used as a basis for finding motivation to combine references. That is exactly the kind of hindsight reasoning that is prohibited when attempting to establish a *prima facie* case of obviousness under 35 U.S.C. §103.

Respectfully submitted,

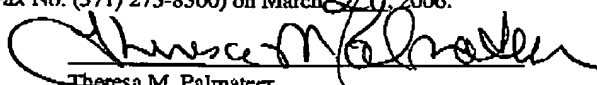
CARLSON, GASKEY & OLDS

By: 
David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: March 29, 2006

CERTIFICATE OF FACSIMILE

I hereby certify that this Notice of Appeal, relative to Application Serial No. 10/319,429 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on March 29, 2006.


Theresa M. Palmateer

N:\Clients\HAMILTON SUNDSTRAND\IP00005\Patent\Pre-Appeal Brief Request for Review.doc